

EXHIBIT 1

In re de Seversky, 177 USPQ 144 (CCPA 1973)

test bath for a period of one minute at a temperature of 150°F. While the one minute contact time would appear at first blush to correspond to the lower limit expressed by Ross, it should be remembered that Ross specifies *spray* application of his coating. That the method employed in the affidavit would adversely effect the amount of time needed to obtain a suitable coat as compared to a *spray* application is indicated by appellants' own specification, wherein it is stated:

As is known in the art, the contact times for obtaining the desired coating will vary widely, depending upon the application techniques used, suitable contact times normally being within the range of several seconds to 10 or more minutes. Typically, coatings are obtained when using about 10 seconds to 2 minutes in spray applications, and in about 1 to 5 minutes when the metal surface is immersed in the coating solution.

No explanation is given why an immersion technique was chosen for the comparison in spite of the fact that Ross called for spraying. Nor is there any explanation given as to why the contact time was not lengthened to compensate for the change in coating techniques. There are other discrepancies which, by themselves, would probably not fatally taint the comparison, but nevertheless tend to weaken it. For example, no reason is given why 150°F. was chosen for the comparison. That temperature is within Ross' range, but Ross' preferred temperature is 160°F., and both of the examples in appellant's specification were run at 70°C. (158°F.). While the record shows that these temperatures are not critical, a test of Ross' composition under his preferred conditions would have carried more weight. In summary, we find appellants' evidence insufficient to establish that the properties of appellants' compositions are unexpectedly better than those of Ross' compositions.

The situation with regard to the comparison between bath A and bath B is somewhat different. Here we have two coating baths having the same concentrations of phosphate, fluoride and molybdate anions, bath A containing sodium cations and bath B containing ammonium cations; with identical metallic materials undergoing identical treatment. While bath A did produce a coating on aluminum, the coating produced by bath B is much darker. We think that this is some evidence that substitution of ammonium for the alkali metal cations would have a real effect on the composition's ability to coat aluminum. We consider that this evidence, together with Saad's statement that the darker coating obtained through bath B was "surprising and unexpected," is probative on the question of obviousness, and that it gives some indication

that the substitution of ammonia for alkali metal ions would not have been obvious. However, considering the qualitative nature of the results, the fact that the testing was performed at the lower limit of the contact times specified in appellants' specification for immersion coating techniques, and the fact that the prior art contains indications that similar phosphating compositions would have been expected to operate effectively on various metals including aluminum, we conclude that appellants have not established as a general proposition that the substitution of ammonium for alkali metal ions results in a composition which gives unexpectedly improved coatings on aluminum. The results obtained using bath C on aluminum lend but little support to appellants' case, for, as noted above, that composition was used in a manner other than that specified by Ross, and there was no comparison made between bath C and a bath identical to bath C except for the use of ammonium salts instead of the sodium salts. Thus appellants' evidence, though probative, is insufficient to rebut the case for obviousness established by the Patent Office.

Finding that the case for obviousness of the claimed subject matter has been neither rebutted nor shown to be based on erroneous reasoning or misinterpretation of the references, we *affirm* the decision of the board.

Court of Customs and Patent Appeals

In re DE SEVERSKY

No. 8816

Decided Mar. 8, 1973

PATENTS

1. Applications for patent — Continuing (§15.3)

Interference — Reduction to practice — Constructive reduction (§41.755)

Statement in application that it is "continuation-in-part" of prior application is insufficient to incorporate therein any part of prior application; all that it means is that insofar as disclosure of application finds corresponding disclosure in prior application, the application is entitled to filing date of prior application.

2. Interference — Reduction to practice — Constructive reduction (§41.755)

Specification — Reference to other disclosures (§62.5)

Mere reference to another application, patent, or publication is not an incorporation

of anything therein into application containing such reference for purposes of disclosure required by 35 U.S.C. 112; likewise, it does not serve to bring a disclosure within requirements of section 120 so as to give a later application the benefit of filing date of earlier application; later application must itself contain the necessary disclosure; purpose of "incorporation by reference" is to make one document become a part of another by referring to the former in the latter in such a manner that it is apparent that cited document is part of referencing document as if it were fully set out therein.

Particular patents—Precipitator

de Seversky, Multi-Concentric Wet Electrostatic Precipitator, claims 1 and 10 of application refused.

Appeal from Board of Appeals of the Patent Office.

Application for patent of Alexander P. de Seversky, Serial No. 723,810, filed Apr. 24, 1968; Patent Office Group 177. From decision rejecting claims 1 and 10, applicant appeals. Affirmed.

MICHAEL EBERT, New York, N. Y., for appellant.

S. WM. COCHRAN (R. V. LUPO and WILLIAM H. BEHA, JR., of counsel) for Commissioner of Patents.

Before MARKEY, Chief Judge, and RICH, ALMOND, BALDWIN, and LANE, Associate Judges.

RICH, Judge.

This appeal is from the decision of the Patent Office Board of Appeals, adhered to on reconsideration, affirming the rejection of claims 1 and 10 of appellant's application serial No. 723,810, filed April 24, 1968, entitled "Multi-Concentric Wet Electrostatic Precipitator," for obviousness under 35 U.S.C. 103. We affirm.

Generally, the wet precipitator includes two concentric cylinders which define an annular space between them. Contaminated air or gas to be cleaned is directed through this annular space. Water is caused to flow on the inside surface of the outer cylinder as well as on the outside surface of the inner cylinder. A discharge electrode structure is disposed within the annular space to establish an electrostatic field between the liquid films which line the annular passage. Contaminated gas is introduced through the bottom end of the passage between the cylinders through annular Venturi slots and is subjected to the electrostatic field which causes the particles in the

gaseous stream to become ionized and migrate to the collecting films on the surfaces of the tubes lining the passages. The liquid films then carry the extracted matter away into a drain.

The significant aspect of this invention is the Venturi inlet which causes the gas flow to spread outwardly against the water films and press them against the walls of the annular passage. Claim 1 reads (emphasis ours):

1. An electrostatic wet precipitator comprising:

(a) concentrically arranged collector tubes defining at least one vertically-disposed annular gas passage,

(b) means to produce downwardly-flowing films of liquid on the complementary surfaces of adjacent tubes which line said passage thereby to form liquid collectors,

(c) a discharge-electrode structure disposed within said passage in spaced relation to said liquid collectors;

(d) inlet means including a *Venturi opening* to feed a contaminated gaseous stream into the lower end of each passage to produce an expanding gas which flows upwardly through said passage in counter-current relationship to said liquid films to force said films against said surfaces to maintain the uniformity thereof,

(e) means to apply a high voltage between said discharge-electrode structure and said liquid collectors to ionize the contaminants in the gaseous stream flowing through said passage to cause migration of contaminants toward said liquid collectors and thereby purify the gas; and

(f) outlet means at the upper end of said passage to discharge the purified gas.

Claim 10 is a dependent claim and no separate argument is made as to its patentability if claim 1 is not patentable.

The references principally relied on and the only ones we need consider are:

Nesbit 1,357,202 Oct. 26, 1920

Burns 1,250,088 Dec. 11, 1917

de Seversky (A) 3,238,702 Mar. 8, 1966

It is unnecessary to discuss the disclosures of these references because of an admission by appellant made in his reply brief before the board and in substance repeated at oral argument in this court, as follows:

The primary question before the Board is whether there is any prior-art reference of record, whose date is effective against the instant application, which discloses a Venturi inlet for feeding contaminated gas into an electrostatic precipitator tube.

If such a reference exists, then appellant concedes that this reference, when combined with the other references of record, makes

the present invention obvious and unpatentable. However it is appellant's contention that de Seversky (A), which discloses a Venturi inlet, is not an effective reference whereas those references which are effective do not even remotely disclose a Venturi inlet.

The solicitor's brief, in turn, contains the admission that "Nesbit and Burns do not disclose Venturi inlets in the contaminated gas openings of their precipitators."

The solution of this case, therefore, depends upon the answer to a single question of law: has appellant overcome the date of the de Seversky (A) patent so that it is not available as a reference? There is, of course, no question that de Seversky (A) is a good reference unless its date is overcome because it issued as a patent over two years before the application at bar was filed.

Appellant argues here, as he did below, that de Seversky (A) is not available as a reference because he is entitled to the date of a parent application filed in 1960, which antedates the de Seversky (A) patent, in which certain disclosure of a Venturi gas inlet is incorporated by reference from a still earlier grand-parent application filed in 1955, referred to as de Seversky (C). The sequence is as follows:

I. de Seversky (C)—Patent 3,053,029—Sept. 11, 1962. Grandparent, filed January 5, 1955.

II. de Seversky parent, application serial No. 53,255. Filed August 31, 1960, a "continuation-in-part" of I.

III. de Seversky instant application, serial No. 723,810. Filed April 24, 1968, a "continuation-in-part" of II.

It will be seen that so far as antedating de Seversky (A) is concerned, appellant relies for filing date only on serial No. 53,255, II above. That parent application, however, is totally devoid of any reference to a Venturi inlet and by itself is of no help to appellant as support for the appealed claims. Appellant admits to this defect in the parent application, saying in his brief, "parent application Serial No. 53,255 did not directly disclose a Venturi inlet." He urges, however, that the defect is cured because the grandparent, de Seversky (C), discloses a Venturi inlet and because the parent application is a "continuation-in-part" of the grandparent that disclosure is, ipso facto, "incorporated by reference" in the parent.

* See the opinion of the Court of Appeals for the District of Columbia in *de Seversky v. Brenner*, 137 U.S. App. D.C. 369, 424 F.2d 857, 164 USPQ 495 (1970), in an action under 35 U.S.C. 145 on claim 20 of serial No. 53,255, the rejection of which was affirmed, bearing on this point.

[1] It should be noted in this connection that the parent application, No. 53,255, contains no "incorporation-by-reference" language whatsoever. Its only relation to de Seversky (C) is indicated by the simple statement that it is a "continuation-in-part" thereof. That language is insufficient to incorporate any part of de Seversky (C) into the parent case. All it means is that insofar as the disclosure of the parent finds corresponding disclosure in the grandparent, the parent is entitled to the filing date of the grandparent. 35 U.S.C. 120.

Appellant is confusing two distinctly different things: (1) the right to have benefit of the filing date of an earlier application under § 120 for subject matter claimed in a later application because that subject matter is disclosed in an earlier application to which "a specific reference" is made—i.e., a reference to the earlier application per se, and (2) the incorporation by reference in an application of matter elsewhere written down (not necessarily in a patent application), for economy, amplification, or clarity of exposition, by means of an incorporating statement clearly identifying the subject matter which is incorporated and where it is to be found.

Appellant's parent application, serial No. 53,255, is not, however, in either category (1) or (2) above. The Venturi inlet is not disclosed therein and the application contains no statement which incorporates anything by reference. There is nothing but the statement that the parent is a "continuation-in-part" of the grandparent application, now the issued de Seversky patent (C).

An argument similar to that appellant is making here was made in *In re Lund*, 54 CCPA 1361, 376 F.2d 982, 153 USPQ 625 (1967), where the Patent Office contended that disclosure in an abandoned application was "incorporated by reference" into the disclosure of a patent used as a reference by virtue of the statement that the application for the patent was a "continuation-in-part" of the abandoned application. We there held that such a statement does not operate to incorporate in an application any part of the disclosure of the parent application so referred to.

[2] To be sure, the statement that an application is a continuation-in-part, or a continuation, or a division, or in part a continuation of another application is in a broad sense a "reference" to the earlier application, but a mere reference to another application, or patent, or publication is not an incorporation of anything therein into the application containing such reference for the purposes of the disclosure required by 35 U.S.C. 112. Likewise it does not serve to bring a disclosure within the requirements of 35 U.S.C. 120 so as to give a later application the benefit of the fil-

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177 USPQ

In re Herschler

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ing date of an earlier application. The later application must itself contain the necessary disclosure. As we said in *Lund*, 153 USPQ at 631,

As the expression itself implies, the purpose of "incorporation by reference" is to make one document become a part of another document by referring to the former in the latter *in such a manner* that it is apparent that the cited document is part of the referencing document as if it were fully set out therein. [Emphasis added.]

We held in *Lund* that the mere statement that an application is a "continuation-in-part" does not do that. Appellant relies on language in *Lund* but that case decided the legal question appellant presents here flatly contrary to his contentions.

Since there is admittedly no disclosure of the crucial Venturi inlet in appellant's parent application, No. 53,255, and that parent application contains no incorporation by reference of any of the disclosure of the de Seversky (C) grandparent case, appellant is entitled to the filing date of neither for the subject matter of the appealed claims and the de Seversky (A) reference has not been antedated or overcome. In view of the admission made, the appealed claims are not patentable. The decision of the board is *affirmed*.

Court of Customs and Patent Appeals

In re HERSCHLER

No. 8889

Decided Mar. 8, 1973

PATENTS

Particular patents—Plant Tissue

Herschler, Enhanced Plant Tissue Penetration, claims 16, 27 to 29, 35, 36, and 38 of application allowed.

Appeal from Board of Appeals of the Patent Office.

Application for patent of Robert J. Herschler, Serial No. 615,377, filed Feb. 13, 1967; Patent Office Group 120. From decision rejecting claims 16, 27 to 29, 35, 36, and 38, applicant appeals. Reversed.

ROBERT E. HOWARD (THOMAS R. LAMPE of counsel) both of San Francisco, Calif., for appellant.

S. WM. COCHRAN (FRED E. MCKELVEY of counsel) for Commissioner of Patents.

Before MARKEY, Chief Judge, and RICH, AMOND, BALDWIN, and LANE, Associate Judges.

LANE, Judge.

This appeal is from the decision of the Board of Appeals, adhered to on reconsideration, sustaining the rejection of claims 16, 27, 28, 29, 35, 36 and 38 of appellant's application¹ entitled "Enhanced Plant Tissue Penetration" as unpatentable under 35 U.S.C. 10, in view of a publication of The Stepan Chemical Company (hereafter Stepan).² We reverse. Appellant describes his invention as follows:

This invention relates to a method and compositions whereby the penetration of plant-active agents into a living plant may be enhanced. More particularly, the invention relates to a method and compositions where plant-active agents are applied to plants along with dimethyl sulfoxide so that they may be penetrated into plant tissue which previously barred penetration or permitted penetration of the agents to a lesser degree.

The invention clearly stems from the recognition of the ability of dimethyl sulfoxide (hereafter DMSO) to enhance the penetration of a plant-active agent into the plant tissue.

Within the sense of the term "plant-active agent," appellant includes "plant growth regulators, nutrients, some herbicides, insecticides, fungicides, virucides, antibiotics, [and] defoliants * * *," which "are only effective to the extent that they can penetrate into plant tissue." Appellant also contemplates the improvement in the effectiveness of such agents as "pesticides, colorants, odorants, [and] defoliants * * *," agents which apparently can perform their functions by their presence on only the surface of the plant but which seemingly work better with penetration.

Claims 16 and 35 are representative of the appealed claims, all of which are method claims, and read as follows:

16. A method of enhancing penetration of a plant-active agent into the living tissue of a living rooted plant, said agent being capable of effecting a physiological response within the plant, which comprises contacting the plant with a liquid composition

¹ Serial No. 615,377 filed February 13, 1967, as a continuation-in-part application of Serial No. 344,558 filed February 13, 1964, which was, in turn, a continuation-in-part application of both Serial No. 203,743 filed June 20, 1962, and Serial No. 67,493 filed November 7, 1960.

² "Solubilities of Various Substances in Dimethyl Sulfoxide," January 1956, pp. 1-10.

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